



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,261	02/27/2001	Klaus Akilles Lunden	0459-0495P	8716

2292 7590 05/13/2003

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

FORTUNA, JOSE A

ART UNIT PAPER NUMBER

1731

DATE MAILED: 05/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/701,261

Applicant(s)

LUNDEN ET AL.

Examiner

José A Fortuna

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 2/27/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 24-47 is/are pending in the application.
- 4a) Of the above claim(s) 43-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 24-42, 46 and 47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 13.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1731

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: in page 8, lines 13-16, the unit of the porosity is different than the used throughout the specification, i.e., $\mu\text{M}/\text{Pas}$ instead of $\mu\text{m}/\text{Pas}$, (capital M is used), are they the same units or the meaning is different? Note also that the values seem to be 100 times higher.

Appropriate correction is required.

Claim Rejections - 35 U.S.C. § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 24-42 and 46-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gill et al., US Patent No. 4,892,590.

Gill et al. teach a method of making paper and paper made thereof, in which a colloidal, precipitated calcium carbonate, (PCC), is added to the pulp in amounts up to 3%, see abstract and column 3, lines 44-48. Gill et al. teach that the surface area, (BET), of the PCC is between 10 to 200 m^2/g , see column 3, lines 24-28, which is within the claimed range. Gill et al. teach the

Art Unit: 1731

combination of the PCC with other fillers, see column 3, lines 49-68. Gill et al. are silent with respect to the use of wood-containing pulp. However, Gill et al. do not teach that their invention can be used just a specific type of pulp and therefore, one of ordinary skill in the art would have reasonable expectation of success if Gill et al. invention is used in either wood-free or wood containing pulps.

Gill et al. do not teach the super calendering of the paper to make a SC, SC-A or SC-B nor newsprint, paper. However one of ordinary would have reasonable expectation of success if the base paper disclosed by the references is used to make any type of paper including Super Calendered papers, either SC-A or SC-B, or newsprint paper. As to the porosity of the paper, this seems to be either inherent to the paper disclosed by the references, since the addition amount is within the claimed range or at least the minor modifications to obtain the claimed porosity would have been obvious to one of ordinary skill in the art. Note that optimizing result effective variables is within the levels of ordinary skill in the art, absent a showing of unexpected results.

Response to Arguments

5. Applicant's arguments with respect to claims 24-41 and 46-47 have been considered but are moot in view of the new ground(s) of rejection.

6. Applicant's arguments filed on February 27, 2003 have been fully considered but they are not persuasive.

Art Unit: 1731

Applicants argue that Gill et al. do not teach the use of wood-containing pulp. The examiner contends that Gill et al. invention is not limited to any specific pulp and therefore, one of ordinary skill in the art would have reasonable expectation of success if Gill et al. invention is used in either wood-free or wood-containing pulps. Note that an invention is not limited by its example(s), but what it teaches to one of ordinary skill in the art.

Applicants also argue that Gill et al. teach a different purpose. While this is true, the range of addition of the colloidal PCC overlaps in both invention and therefore, the function of the PCC is inherently the same, see column 3, lines 44-48, where teach that the proportion of PCC to starch could be from 2:1 and 1:20 and that the starch is added between 0.5 to 1.5%. The latter translate, from the first ratio 1 to 3% of PCC. Note also that the products claims, such as claims 32-41, only require the use of the colloidal PCC, i.e., containing colloidal PCC, and therefore any amount reads over the claims.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to José Fortuna, whose telephone number is (703)305-7498. The examiner can normally be reached on Monday-Friday from 9:30 A.M. to 5:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin, can be reached on (703)308-1164. The fax number for this group is (703)305-7115.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-0661.

When filing a FAX in group 1730, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other

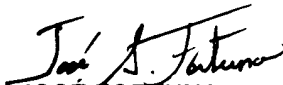
Application/Control Number: 09/701,261

Page 5

Art Unit: 1731

communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

José A. Fortuna
May 12, 2003


JOSÉ FORTUNA
PRIMARY EXAMINER
ART UNIT 1731